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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/528,803	03/20/2000	Paul A. Freiburger	IR-003-C2	6272

21912 7590 02/14/2003
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EXAMINER

BRIER, JEFFERY A

ART UNIT PAPER NUMBER

2672

DATE MAILED: 02/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/528,803

Applicant(s)

FREIBERGER ET AL.

Examiner

Jeffery A. Brier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 68-82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 68-82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed on 01/06/03 has been entered. This amendment amended independent claims 68, 70, 72, 74, 77 and 80. The terminal disclaimer filed on 01/06/03 has been reviewed and is deemed to be proper, thus, the obvious type double patenting rejection has been overcome by the filing of a proper terminal disclaimer. The amendment to the independent claims overcomes the 102 (e) rejections and overcomes the 112 first paragraph rejection except for claim 70 since applicant failed to amend claim 70 at line 6 similar to the other independent claims (and/or remains).

2. The amendment filed 05/20/02 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: on page 2 of that amendment applicant amended page 1 of the specification with "which co-pending application is incorporated by reference for all purposes". This statement was not in the application as filed on 03/20/00, thus, it is new matter since any matter that was in the co-pending application and not in this application at the time of filing this application is matter that was not in this application at the time of filing this application.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 70 and 71 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for the reasons given in paragraph 4 of paper no. 10. Applicant failed to amend claim 70 at line 6 similar to the other independent claims (and/or remains).

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 68-82 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 68:

At line 7 "the apparatus" lacks antecedent basis in the claim (the was added by applicant in the 01/06/03 amendment). At line 15 "and/or" is indefinite because "the timing" and "the duration" are the same as well as "the timing" and "the sequencing". See applicants' specification at page 34 line 1 to page 35 line 31. Thus, controlling the duration or timing does not clearly claim applicants system since duration and timing are the same, thus, alternatively claiming one of them is still claiming the same thing.

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Similarly controlling the timing or the sequencing does not clearly claim applicants system since timing and sequencing are the same. At lines 13-15 "the respective content provider may provide scheduling instructions tailored to the set of content data to control the duration, sequencing, and/or timing of the display of the set of content data" is indefinite because it is not clear if these scheduling instructions are controlling the display of the images generated from the set of content data at lines 6-9 since lines 13-15 are displaying the content data and not the images generated from the content data.

Claim 70:

At lines 8-9 "the apparatus" lacks antecedent basis in the claim (the was added by applicant in the 01/06/03 amendment). At line 17 "and/or" is indefinite for the same reasons given for claim 68. At lines 13-15 "the respective content provider may provide scheduling instructions tailored to the set of content data to control the duration, sequencing, and/or timing of the display of the set of content data" is indefinite for the reasons given for claim 68.

Claim 72:

At line 14 "and/or" is indefinite for the same reasons given for claim 68. At lines 13-15 "the respective content provider may provide scheduling instructions tailored to the set of content data to control the duration, sequencing, and/or timing of the display of the set of content data" is indefinite for the reasons given for claim 68.

Claim 74;

At line 16 "and/or" is indefinite for the same reasons given for claim 68. At lines 15-17 "the respective content provider may provide scheduling instructions tailored to the set of content data to control the duration, sequencing, and/or timing of the display of the set of content data" is indefinite for the reasons given for claim 68.

Claim 77:

At line 15 "and/or" is indefinite for the same reasons given for claim 68. At lines 14-16 "the respective content provider may provide scheduling instructions tailored to the set of content data to control the duration, sequencing, and/or timing of the display of the set of content data" is indefinite for the reasons given for claim 68.

Claim 80:

At line 16 "and/or" is indefinite for the same reasons given for claim 68. At lines 15-17 "the respective content provider may provide scheduling instructions tailored to the set of content data to control the duration, sequencing, and/or timing of the display of the set of content data" is indefinite for the reasons given for claim 68.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 68, 70, 72, 74, 76, 77, 79, 80 and 82 are rejected under 35 U.S.C. 102(e) as being anticipated by Farber et al., U.S. Patent No. 5,819,284. Farber describes a system that displays information from content providing sources while the user is not performing a primary interaction with the display device or an apparatus associated with the display device.

Claim 68:

Farber teaches providing a set of content data from each of several sources, traffic, weather, financial, and other, figure 2, to a display device or content providing system, step 323. The images displayed in step 323 are during the screen saver mode, thus, the images do not distract the user from a primary interaction with the display device or associated apparatus. Farber at column 4 lines 8-11 teaches “the respective content provider may provide scheduling instructions tailored to the set of content data to control the duration, sequencing, and/or timing of the display of the set of content data” since the providing may send information (new information is an instruction to display new information) at the provider’s control to the client, thus controlling the duration, sequencing, and timing of the images displayed and since the claim does not claim the particulars of how the claimed system responds to the scheduling instructions to perform the claimed function of controlling the duration, sequencing, and/or timing of the display of the set of content data.

Claim 70:

This claim is similar to claim 68 with the exception that it is a computer readable medium claim and it claims at line 12 instructions for auditing the display of sets of

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content data by the display device. For the computer readable medium difference note Farber is a computer system and note Farber's claim 11, thus, Farber teaches this aspect of claim 70. As for the instructions for auditing aspect of the claim note that in order to float the images 401-406 illustrated in figure 4 and described at column 6 lines 40-63 the system needs to keep track of the images, thus, an auditing is performed commensurate is scope with the broadly claimed instructions for auditing.

Claim 72:

This claim is broader than claim 68 since it does not claim the auditing step. Like claim 70 this claim is a computer readable medium claim. For the computer readable medium difference note Farber is a computer system and note Farber's claim 11, thus, Farber teaches this aspect of claim 72.

Claim 74:

This claim is similar to claim 68 with the exception that it is a system claim and since it claims selection by a user of one or more control options. For the system difference note Farber is a computer system. As for the selection by a user of one or more control options note the claim does not claim when the user selects the options, it just claims selection of one or more control options during the selective display of the image or images generated from the set of content data. In figure 2 Farber shows a user profile database which is formed by the user, see column 4 lines 42-62. Thus the database is a user input apparatus that enables selection of one or more control options.

Claim 76:

See column 1 lines 35-40 of Farber. Thus, Farber teaches a link control option that enables the user to establish a link with an information location.

Claims 77 and 80:

These claims claim the same functional limitations that claim 74 claims. The difference being these claims are a method claim (claim 77) and a computer readable medium claim (claim 80). Farber clearly teaches the claimed method and the claimed computer readable medium.

Claims 79 and 82;

These claims claim the same functional limitations that claim 76 claims. The difference being these claims are a method claim (claim 79) and a computer readable medium claim (claim 82). Farber clearly teaches the claimed method and the claimed computer readable medium.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 69, 71, 73, 75, 78 and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farber et al., U.S. Patent No. 5,819,284. Claim 69 adds to claim 68 the limitation "wherein the display device comprises a television". Farber discusses at

column 1 lines 10-20 various display devices but does not explicitly mention a television. Televisions were well know when the invention was made, the examiner takes official notice of this fact, to be one of the many types of display devices that may be used as a computer monitor. Thus, it would have been obvious to one of ordinary skill in the art when the invention was made to use a television as the display device in Farber since it is readily available, thus reducing cost, and it provides the same function as Farber's display. Claims 71, 73, 75, 78 and 81 all add the limitation of a television as the display device to their parent claims. These claims would have been obvious for the same reasons given for claim 68.

Response to Arguments

10. Applicant's arguments with respect to claims 68-82 have been considered but are moot in view of the new ground(s) of rejection.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A. Brier whose telephone number is (703) 305-4723. The examiner can normally be reached on M-F from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (703) 305-4713).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks


Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.


Jeffery A Brier
Primary Examiner
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